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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,408	05/18/2005	Naoyuki Mochida	P27937	6002
52123 7590 04/03/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
NGUYEN, TRAN N				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
04/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

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### Office Action Summary

**Application No.**

10/535,408

**Applicant(s)**

MOCHIDA, NAOYUKI

**Examiner**

Tran Nguyen

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/15/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 09/02/2005, 12/15/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

This communication is in response to the communication filed 12/15/2008.

Pending claim(s): 1-10.

***Priority***

Acknowledgment is made of Applicant's claim for priority to application PCT/JP04/11302 filed 07/30/2004, Japanese application 2003-287564 filed 08/06/2003, and Japanese application 2004-220552 filed 07/28/2004.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 09/02/2005, 12/15/2008 is entered and considered to the extent possible by Examiner.

The information disclosure statement filed 09/02/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

In particular, Katsukawa (JP 2002/0919785), Kitagawa (reference 7), and Shimazu (reference 8) have not been provided.

The information disclosure statement filed 09/02/2005 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it

is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

In particular, all separately cited Japanese patent publications have not been considered because no English translation has been submitted, and Applicant did not provide a concise explanation of the relevance for each reference.

The information disclosure statement filed 12/15/2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

In particular, Chinese patent publication 1232218 has not been considered because no English translation has been submitted, and Applicant did not provide a concise explanation of the relevance for this reference.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: acronyms may render the claim indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-10 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a "relay server" comprising a plurality of "section" limitations.

When read in light of the specification and the level of ordinary skill in the art, Examiner, in applying the broadest and most reasonable interpretation, interprets this claim to recite a system comprising software *per se*.

Therefore, this claim is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claims 2-7, 9, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 8, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v.*

*Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

The steps of this claim do not require a particular machine. Therefore, the claim fails the "machine" test.

Although the claim recites "establishing a session", this does not amount to a physical transformation. Therefore, the claim fails the "transformation" test.

Because the claim fails both prongs of the "machine or transformation" test, the claim is found to be directed towards nonstatutory subject matter.

As per claim 10, this claim is rejected for at least the same rationale as applied to claim 1 above, and incorporated herein.

Additional clarification is requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-10 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Krishnaswamy (5867494, hereafter "Kris").

As per claim 1, Kris teaches a frame relay system (column 17 line 65 to column 18 line 9) comprising a Web server (Figure 40) capable of establishing a session between a user and a conference server (Figure 110), comprising:

(a) software (reads on a "request reception section") capable of receiving a connection request (Figure 11-12);

(b) software (reads on an "authentication section") capable of authenticating the user (column 26 line 30-34);

(c) software (reads on a "search section") capable of searching for data (column 40 line 51-53);

(d) software (reads on a "service inquiry relay section") capable of determining if the client may connect with the server, or if operator intervention is required to restore an inactive or lost connection (column 41 line 12-15);

(e) software (reads on a "response relay section") capable of receiving the request and connecting the client to the server (Figure 11-12);

(f) software (reads on a "confirmation relay section") capable of connecting the client to the server (Figure 11-12).

As per claim 2, Kris teaches Internet protocols capable of providing data communication rules (column 11 line 58-60).

Kris also teaches software logic (reads on "rules") capable of controlling the connection (Figure 11-12 and throughout).

As per claim 3, Kris teaches:

(a) software (reads on a "disconnection request reception section") capable of receiving a disconnect signal from the user (Figure 11);

(b) software (reads on a "session control section") capable of billing based on duration (column 20 line 35-39);

(c) software (reads on a "time billing section") capable of billing based on duration (column 20 line 35-39).

As per claim 4, Kris teaches that the system is capable of requesting billing functionality (column 20 line 35-39, line 50-55).

As per claim 5, Kris teaches software capable of changing the user's call routing (Figure 58).



As per claim 6, this claim is rejected for substantially the same rationale as applied to claim 5 above, and incorporated herein.

In particular, call routing is a form of "transfer request", wherein the user requests that the call be routed elsewhere.

As per claim 7, Kris teaches verifying the identify of call participants and connecting the participants to a conference call (Figure 110).

As per the set of claim(s): 8, 9, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 1, respectively, and incorporated herein.

As per claim 10, this claim is rejected for substantially the same rationale as applied to claim 3 above, and incorporated herein.

Kris further teaches using SIP (column 55 line 54).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./  
Examiner, Art Unit 3626  
03/28/2009

/C. Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626